

**REMARKS/ARGUMENTS**

Claims 1-3, 5-12, 15-17 and 23-29 are pending in the application. By this Amendment, claims 1 and 12 are amended; claims 4, 13, 14 and 18-22 are canceled, and claims 23-29 are added. Reconsideration and withdrawal of the rejections in view of the foregoing Amendments and the following remarks is respectfully requested.

The Office Action asserts a Restriction Requirement. During a November 8, 2005 telephone conference with the Examiner, the Applicant provisionally elected Group I, claims 1-11 and 15-17. Applicant hereby confirms the election of Group I, claims 1-11 and 15-17. By this Amendment, the non-elected claims are canceled. Note that claim 12, which was previously a part of non-elected Group II, has been amended to become a part of elected Group I. As a result, claim 12 has not been canceled.

The Office Action also notes that the Information Disclosure Statement filed on June 9, 2004 failed to include the excerpt from a website relating to a description of Kevlar. Enclosed herewith is a new copy of the descriptive materials. Also enclosed herewith is a form PTO-1449 listing the descriptive materials. The Examiner is requested to initial and return a copy of the form PTO-1449 to indicate consideration of the materials.

The Office Action rejects claim 4 under 35 USC § 112, second paragraph. By this Amendment, claim 4 has been canceled. Accordingly, it is believed that the rejection is moot.

The Office Action rejects claims 1, 2, 9, 15 and 16 under 35 USC § 102(b) over Ell (U.S. Patent No. 3, 251,919). Because Ell fails to disclose or suggest all the features of these claims, the rejection is respectfully traversed.

Ell discloses a method of molding plastic paraffin scraper blades onto a sucker rod which is used in a completed and producing oil well. In the Ell method, a metallic sucker rod is inserted into a mold, and plastic paraffin scraper blades are injection molded onto the metal rod. Examples of different shapes for the scraper blades are shown in Figures 3a-11 of Ell.

In contrast, claim 1 recites a downhole tool for conditioning a casing or liner wall. Claim 1 recites a substantially cylindrical body connectible in a work string, a sleeve located around the body, and one or more blades located on the sleeve. Claim 1 further recites that each blade has a circular peripheral edge distal to the sleeve and that each blade is manufactured from a composite material which comprises a polymetric fiber.

The downhole tool recited in claim 1 is used in a considerably different environment than the sucker rod disclosed in the Ell reference. The downhole tool of claim 1 must be connectable to a work string. As is understood by those of ordinary skill in this art, a work string is a line or tubular run that extends downhole and that includes one or more tools for performing specific work operations on a well bore or casing. For instance, a work string could include a drilling tool for forming a well, or a cleaning tool for cleaning a newly formed well bore. As disclosed in the present application, and as shown in Figures 1a and 1b, the cylindrical body 12 includes a threaded portion 18 and a box section 22 which allows the cylindrical body to be connected to a mandril in a work string.

As noted above, the sucker rods in the Ell reference are used in a producing oil well. As such, they are not used as a tool in a work string, nor are they configured to be attached to a

Serial No. **10/781,937**

work string. Because claim 1 recites that the cylindrical body is connectable to a work string, it is respectfully submitted that the Ell reference does not anticipate claim 1.

In addition, claim 1 recites that each of the blades has a circular peripheral edge distal to the sleeve. Examples of the claimed blades are clearly shown in Figures 1b and 2b of the present application. Each of the blades is a circular disk shaped blade with an aperture cut through the center of the disc so that the blade can be fitted around the cylindrical body. In contrast, in the Ell reference, none of the scraper blades are circular, nor do they have a circular peripheral edge.

For all the reasons given above, it is respectfully submitted that claim 1 is allowable over Ell. Claims 2 and 9 depend from claim 1 and are allowable for at least the same reasons.

Claim 15 recites a method of conditioning a casing or liner in a well bore. Claim 15 recites locating on a work string, a blade having a circular peripheral edge and made from a composite material which comprises a polymetric fiber. As noted above, the Ell reference does not disclose or suggest locating such a blade on a work string. The sucker rods in the Ell reference cannot be connected to a work string. In addition, the Ell reference does not disclose the use of a blade having a circular peripheral edge. Accordingly, it is respectfully submitted that claim 15 is also allowable over Ell. Claim 16 depends from claim 15 and is allowable for the same reasons.

In view of the foregoing, withdrawal of the rejection of claims 1, 2, 9, 15 and 16 is respectfully requested.

The Office Action rejects claims 8 and 10 under 35 USC § 103(a) over Ell, in view of Evans (U.S. Patent No. 6,312,637). The rejection is respectfully traversed.

Claims 8 and 10 depend from claim 1 and include all the features of claim 1. As noted above, Ell fails to disclose or suggest all the features of claim 1. The Evans reference fails to cure these deficiencies of Ell. Specifically, Evans also fails to disclose or suggest a downhole tool which is connectable in a work string which includes blades having a circular peripheral edge. Accordingly, withdrawal of the rejection of claims 8 and 10 is respectfully requested.

The Office Action indicates that claims 3-7, 11 and 17 contain allowable subject matter. Indication of allowable subject matter is acknowledged with appreciation. For the reasons discussed above, Applicant respectfully declines to rewrite these claims in independent form at the present time.

By this Amendment, claims 23-29 are added to the application. Claims 23-26 depend from claim 1. Claims 27-29 depend from claim 15. It is respectfully submitted that these claims are allowable for reasons similar to those discussed above.

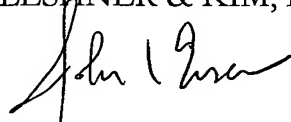
### **CONCLUSION**

In view of the foregoing amendments and remarks, it is respectfully submitted that the application is in condition for allowance. If the Examiner believes that any additional changes would place the application in better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number listed below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this,

concurrent and future replies, including extension of time fees, to Deposit Account 16-0607 and please credit any excess fees to such deposit account.

Respectfully submitted,  
FLESHNER & KIM, LLP



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Enclosures: PTO-1449  
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**Date: May 30, 2006**

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